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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,043	01/28/2004	Tomoko Maruyama	204552031700	9599
7590 Barry E. Bretschneider Morrison & Foerster LLP Suite 300 1650 Tysons Boulevard McLean, VA 22102		10/02/2008	EXAMINER CHEEMA, UMAR	
			ART UNIT 2144	PAPER NUMBER
			MAIL DATE 10/02/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/765,043	<b>Applicant(s)</b> MARUYAMA ET AL.
	<b>Examiner</b> UMAR CHEEMA	<b>Art Unit</b> 2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 September 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/0256/06)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. This action is in response to the Request for continued examination (RCE) filed on 09/18/2008. Claims 1-15 are pending with claims 1, 11, and 12 as being amended.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 09/18/2008 has been entered.

### *Response to Arguments*

3. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh (US 2001/0021037 A1) in view of McAfee et al. (McAfee) (US 2004/0021889).

**Regarding claim 1,** Itoh substantially discloses the invention as claimed a network scanner device for transmitting image data through networks (see abstract, pg. 1, par. 0015-0016) comprising: a reading section for scanning a document to obtain image data (see abstract, pg. 1, par. 0018), a first setting section for setting up a recipient address to which the image data is to be transmitted (pg. 1, par. 0019), a second setting section for setting up an optional sender address representing a sender in place of a sending station address specifying the network scanner device by accepting a designation of the sender address which is distinct from the sending station address (see pg. 1, par. 0020, fig. 10- where IP address is the address of the sender instead of the sending location address; also see par. 0059, 0146; sender and IP address of the transmitting destination), and a transmission control section for carrying out control for adding to the image data the sender address set by the second setting section (see pg. 1, par. 0017, pg. 6, par. 0146, fig. 10, pg. 5, par. 0111) and transmitting the image data to the recipient address set by the first setting section (see pg. 1, par. 0022).

Itoh substantially discloses the invention as claimed above for the given reason however does not explicitly discloses wherein setting up a senders address is senders

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address instead of sending station address. However in the same field of invention McAfee discloses wherein setting up a senders address is senders address instead of sending station address (see abstract, par. 0006-0007 also figure 3 and the details related; a scanner device, e.g. a multi function peripheral device incorporating scan, copy and print functions, and a method of operation, in which the device is user operable to directly establish a communication link with a network server having email receive and transmit functionality, e.g. an internet server, and to transmit to the network server over the transmission link, message header data including at least an email address of a sender and of at least one intended recipient; accompanied by the scanned content of a source document scanned by the device, to the network server for transmission to the or each recipient).

It would have been obvious to one of the ordinary skill person in the art of networking to combine the teaching of Itoh and McAfee for a network scanner device for transmitting data over a network. Motivation for doing so would have been the allowing user to authenticate data for verification purpose and transmit data more securely (see McAfee: par. 0009).

**Regarding claim 2,** Itoh discloses a network scanner device as claimed in claim 1, further comprising a one-touch setting section (see pg. 1, par. 0021) for setting up the recipient address and the sender address simultaneously (see pg. 1, par. 0021, pg. 2, par. 0050).

**Regarding claim 3**, Itoh discloses a network scanner device as claimed in claim 2, wherein the one-touch setting section (see pg. 1, par. 0021) carries out setting of the recipient address and the sender address, in accordance with instructions by the sender (see pg. 2, par. 0050).

**Regarding claim 4**, Itoh discloses a network scanner device as claimed in claim 2, further comprising a display section that is capable of displaying information including the recipient address and the sender address (see fig. 1, pg. 2, par. 0049, pg. 3, par. 0070, pg. 6, par. 0146).

**Regarding claim 5**, Itoh discloses a network scanner device as claimed in claim 1, further comprising a storage section in which candidates of recipient addresses associated with each sender address are stored (see pg. 3, par. 0074), wherein, on setting of the sender address, the recipient address is chosen from candidates of recipient addresses associated with the sender address (see fig. 10, pg. 6, par. 0146).

**Regarding claim 6**, Itoh discloses a network scanner device as claimed in claim 1, further comprising a storage section in which sender addresses associated with IDs representing users are stored (see pg. 2, par. 0054), wherein the sender address is automatically set up in accordance with an inputted ID (see pg. 3, par. 0073).

**Regarding claim 7**, Itoh discloses a network scanner device as claimed in claim 6, further comprising an ID input prompting section for making a display that prompts input of an ID representing a user, as a condition for start of operations of the device (see fig. 1, pg. 2, par. 0049, pg. 3, par. 0073).

**Regarding claim 8**, Itoh teaches a network scanner device as claimed in claim 1, further comprising an operation panel by which information including the recipient address and the sender address is inputted or chosen (see abstract, pg. 1, par. 0019).

**Regarding claim 9**, Itoh discloses a network scanner device as claimed in claim 1, wherein information including the recipient address and the sender address can be inputted through networks (see pg. 1, par. 0055).

**Regarding claim 10**, Itoh discloses a network scanner device as claimed in claim 1, wherein the sending station address specifying the device is included in contents of a text of mail to which the image data is added (see pg. 5, par. 0132).

**Regarding claim 11**, Itoh substantially discloses the invention as claimed a network scanner device for transmitting image data through networks (see abstract, pg. 1, par. 0015-0016), comprising: image memory in which image data is stored (see fig. 2, pg. 2, par. 0056), a first setting section for setting up a recipient address to which the image data is to be transmitted (see pg. 1, par. 0019), a second setting section for setting up

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an optional sender address representing a sender in place of a sending station address specifying the network scanner device by accepting a designation of the sender address which is distinct from the sending station address (see pg. 1, par. 0020, pg. 6, par. 0146, fig. 10 -- where IP address is the address of the sender instead of the sending location address; also see par. 0059, 0146; sender and IP address of the transmitting destination), and a transmission control section for carrying out control for adding to the image data the sender address set by the second setting section (see pg. 1, par. 0017, pg. 6, par. 0146, fig. 10, pg. 5, par. 0111) and transmitting the image data to the recipient address set by the first setting section (see pg. 1, par. 0022).

Itoh substantially discloses the invention as claimed above for the given reason however does not explicitly discloses wherein setting up a senders address is senders address instead of sending station address. However in the same field of invention McAfee discloses wherein setting up a senders address is senders address instead of sending station address (see abstract, par. 0006-0007 also figure 3 and the details related; a scanner device, e.g. a multi function peripheral device incorporating scan, copy and print functions, and a method of operation, in which the device is user operable to directly establish a communication link with a network server having email receive and transmit functionality, e.g. an internet server, and to transmit to the network server over the transmission link, message header data including at least an email address of a sender and of at least one intended recipient; accompanied by the scanned content of a source document scanned by the device, to the network server for transmission to the or each recipient).

It would have been obvious to one of the ordinary skill person in the art of networking to combine the teaching of Itoh and McAfee for a network scanner device for transmitting data over a network. Motivation for doing so would have been the allowing user to authenticate data for verification purpose and transmit data more securely (see McAfee: par. 0009).

**Regarding claim 12,** Itoh substantially discloses the invention as claimed an image data transmitting method of a network scanner device (see abstract, pg. 1, par. 0015-0016) which attaches image data to electronic mail and transmits the image data through networks (see pg. 1, par. 0112-0113), comprising steps of: scanning a document and obtaining the image data (see pg. 1, par. 0002), setting a recipient address to which the image data is to be transmitted (see pg. 1, par. 0019), setting an optional sender address representing a sender in place of a sending station address specifying the network scanner device by accepting a designation of the sender address which is distinct from an address specifying the network scanner device (see pg. 1, par. 0020, pg. 6, par. 0146, fig. 10 -- where IP address is the address of the sender instead of the sending location address; also see par. 0059, 0146; sender and IP address of the transmitting destination), and adding the set sender address to the image data and transmitting the image data to the set recipient address through the networks (see pg. 1, par. 0112-0113, pg. 7, par. 0174, pg. 5, par. 0111).

Itoh substantially discloses the invention as claimed above for the given reason however does not explicitly disclose wherein setting up a sender's address is sender's address instead of sending station address. However in the same field of invention McAfee discloses wherein setting up a sender's address is sender's address instead of sending station address (see abstract, par. 0006-0007 also figure 3 and the details related; a scanner device, e.g. a multi function peripheral device incorporating scan, copy and print functions, and a method of operation, in which the device is user operable to directly establish a communication link with a network server having email receive and transmit functionality, e.g. an internet server, and to transmit to the network server over the transmission link, message header data including at least an email address of a sender and of at least one intended recipient; accompanied by the scanned content of a source document scanned by the device, to the network server for transmission to the or each recipient).

It would have been obvious to one of the ordinary skill person in the art of networking to combine the teaching of Itoh and McAfee for a network scanner device for transmitting data over a network. Motivation for doing so would have been the allowing user to authenticate data for verification purpose and transmit data more securely (see McAfee: par. 0009).

**Regarding claim 13,** Itoh discloses an image data transmitting method as claimed in Claim 12, wherein the step of scanning a document and obtaining image data (see pg. 1, par. 0015), the step of setting the recipient address to which the image data is to be

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transmitted (see pg. 1, par. 0019), and the step of setting the sender address representing the sender in place of the sending station address specifying the device are carried out in an altered sequence (see pg. 1, par. 0020, pg. 4, par. 0090, pg.7, par. 0164).

**Regarding claim 14**, Itoh discloses a network scanner device as claimed in claim 1, wherein the designation of the sender address is carried out by a user selection from addresses stored in the network scanner device in advance (see par. 0059, 0146; sender and IP address of the transmitting destination).

**Regarding claim 15**, Itoh discloses a network scanner device as claimed in claim 1, wherein the designation of the sender address is carried out by an input of the sender address by a user (see par. 0059, 0146, 0106; figure 7, inputs the IP address as the transmitting destination).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see the form PTO-892 (Notice of Cited Reference) for a list of more relevant prior arts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to UMAR CHEEMA whose telephone number is (571)270-3037. The examiner can normally be reached on M-F 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Jr. Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/U. C./  
Examiner, Art Unit 2144

/William C. Vaughn, Jr./  
Supervisory Patent Examiner, Art Unit 2144